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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,183	02/08/2001	Eric Ellington	OAA-145-A	6456

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EXAMINER

FISCHMANN, BRYAN R

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 07/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,183

Applicant(s)

ELLINGTON

Examiner

Bryan Fischmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 12, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Feb 8, 2001 is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Feb 27, 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Acknowledgments

1. The Amendment (paper 8) filed 6-12-2002 has been entered.

Request for Continued Examination

2. The request filed on 6-12-2002 (paper 7) for a Request for Continuing Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/779,183 is acceptable and an RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

A) Claim 1 recites "...the connecting member/mechanism retains the slide board and step board in a fixed substantially parallel and spaced relationship during use of the snowboard".

It is initially noted that this recitation is inconsistent with the specification (line 25 of sheet 5 to line 1 of sheet 6) which recites "...connecting tubular members...retain the slide board...and step board...in a fixed parallel relationship...". The specification fails to include the word "substantially".

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It is however further noted that the upper and lower boards are basically cantilever beams loaded with a fairly substantial load when in use. It is believed that there is some "substantial" deflection between the boards when in use, such that term "substantially parallel" is not believed appropriate, as it is understood from this recitation that Applicant is claiming that the boards undergo little, or no deflection when in use. As an example, if the boards were made of a high strength steel, the term "parallel", or "substantially parallel" would seem appropriate. If the boards were made of wood, the terms "substantially parallel" would not seem appropriate, as the ends of the boards would undergo "substantial" deflection. It is understood that snowboard and skis are generally made of flexible material and that the lower (slide) and upper (step) board will tend to deflect toward each other during use.

Therefore, it is considered unclear whether Applicant is claiming the entire length and width of the boards remain parallel, or the boards remain parallel only near the connecting members.

Perhaps a more correct wording would be "substantially parallel relationship in the immediate vicinity of the connecting members".

B) Note that claim 9 contains an identical recitation.

C) Note also that the claim 17 recitation "...the slide and step boards are connected via the connecting member so as to substantially prohibit relative pivoting between the boards", is considered unclear as to what is meant by "pivoting". Since the boards are believed to deflect

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towards each other towards the ends of the board during use, they may be broadly interpreted to be “pivoting” about the connecting members.

D) See claim 18 for a similar recitation.

For purposes of this Office Action, it will be assumed that the boards remain “substantially parallel” only in the vicinity of the connecting members and that the boards deflect toward each other, toward the ends.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1-20, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Barbieri, et al, US Patent Application Publication 2002/0070515.

Barbieri teaches a snowboard for sliding over snow, comprising:

an elongated slide board having a slide surface on a lower surface thereof (Figure 1); and

an elongated step board defining a deck on an upper surface thereof, and attached to an upper surface of the slide board in a substantially parallel and spaced relationship via a

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connecting member made of substantially non-compressible material (Figure 1 and paragraph 0024); and

the connecting member/mechanism retains the slide board and step board in a fixed, substantially parallel and spaced relationship during use of the snowboard (see Figure 3 and the 112 2nd portion of this Office Action).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Regarding claims 4 and 5, see paragraph 0021.

Regarding claims 7 and 11, see paragraph 0024

7. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Dodge, US Patent 4,221,394.

Dodge teaches a snowboard for sliding over snow, comprising:

an elongated slide board (10) having a slide surface on a lower surface thereof; and

an elongated step board (34) defining a deck on an upper surface thereof; and

a connecting mechanism (Figure 5) made of substantially non-compressible material connecting the step board to an upper surface of the slide board so as to substantially prohibit relative pivoting between the boards during use of the boards.

Regarding the recitation of “a connecting mechanism made of substantially non-compressible material connecting the step board to an upper surface of the slide board”, note that

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Figure 5 shows the step and slide boards are “connected” by reference numbers 40, 44 and 54.

The cross-hatching on Figure 5 indicates that these parts are metal, which is “substantially non-compressible”.

Regarding the recitation of “substantially prohibit relative pivoting between the boards”, see the 112 2nd portion of this Office Action, noting that Applicant’s boards, at the ends, may be broadly considered to “pivot” about the connecting members, due to deflection of the ends when in use.

Response to Applicant’s Remarks (paper 8) and Examiner’s Comments

8. The amendment (paper 8) particularly the additional recitation of “fixed substantially parallel relationship” in claim 1, or similar wording in other claims, has overcome the Dykema reference, as noted by Applicant, Figure 3 of Dykema shows the boards “pivoting” relative to each other, which is not consistent with a connecting member made of “substantially non-compressible” material.

9. The amendment (paper 8) particularly the additional recitation of “the connecting member/mechanism retains the slide board and step board in a fixed...relationship”, and similar wording in other claims, has overcome the Dodge reference, since Figure 5 of Dykema, as noted by Applicant, has a resilient member (42) which will allow limited relative movement between the two boards, which is not consistent with the term “fixed”.

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10. During an update search, the Examiner discovered the "Barbieri" Patent Application Publication, which just recently published and which was used as a grounds of rejection in this Office Action. Due to the strong similarity between this publication and the Applicant's Instant Invention, it is requested Applicant make the Examiner aware of any known connection between this Publication and the Applicant that would be a factor in regards to Double Patenting

Conclusion

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

BF

07/01/02


MICHAEL MAR
PRIMARY EXAMINER